

Amendment
Serial No. 10/785,104
Attorney Docket No. 042125

REMARKS

Claims 1-19 are pending in the present application and are rejected. Claims 1-19 are herein amended.

Applicant's Response to Claim Rejections under 35 U.S.C. §102

Claims 1-13 were rejected under 35 U.S.C. §102(b) as being anticipated by Graham et al. (U.S. Patent No. 3,271,888).

It is the position of the Office Action that **Graham** discloses the invention as claimed. **Graham** discloses a protective attachment for shoes comprising a body 24 which is attached to a shoe 12 using straps 50, 58, 32 and 42. A resilient member 60 is attached to the inner surface of body 24. In the event of an impact, the bottom edge 82 of body 24 contacts the ground, stopping further movement of the body 24 towards the instep of the wearer's shoe. It is noted that in the event of an impact, the straps 32 and 42 stay tight around the wearer's heel, while straps 50 and 58 slacken below the sole of the shoe.

The Office Action is broadly interpreting the claims to read on **Graham**. In response, Applicant amends the claims to more clearly recite the subject matter of the application. Specifically, as illustrated in Figures 1 and 3, the present application discloses that the curved portion 31 of the protecting member 3 covers the instep portion 211 of the overshoe attaching member 2, as well as the instep portion of shoe 9.

In contrast, the body 24 of **Graham**, which is analogous to a protective member, covers only the instep of the shoe 12. The protective attachment of **Graham** is only attached by straps

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around the heel and under the sole of the shoe 12. Thus, **Graham** does not disclose an instep portion of an attachment member which is covered by the protective member. Applicant respectfully submits this amendment is sufficient to distinguish over **Graham**.

Claims 1-13 were rejected under 35 U.S.C. §102(b) as being anticipated by Wasser (U.S. Patent No. 2,344,069).

It is the position of the Office Action that **Wasser** discloses the invention as claimed. **Wasser** discloses a foot guard wherein a shell body 11 is supported by loop spring 25. The shoe (unnumbered) is attached by the shoe contour loop 27 of the loop spring 25 at the front of the shoe and the rubber tube 35 at the heel of the shoe. Upper loop 30 of loop spring 25 is held in its upper position by the force of the spring such that it is pressed against the underside of the shell body 11. See column 4, lines 22-25. In the event of an impact, the shell body 11 is forced downward such that the bottom edge of the shell body comes into contact with the ground to stop movement of the shell body 11.

The Office Action is broadly interpreting the claims to read on **Wasser**. The Office Action regards the loop spring 25 as an attaching member. In response, Applicant amends the claims to clarify that the curved portion 31 of the protecting member 3 is spaced from the instep portion 21 of the overshoe type attaching member 2. See Figures 1 and 3.

As noted above, **Wasser** discloses that the upper loop 30 of loop spring 25 is pressed against shell body 11. Thus, **Wasser** does not disclose a space between the instep portion of the

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attaching member and the pressing member. Applicant respectfully submits that this amendment is sufficient to distinguish over **Wasser**.

Applicant's Response to Claim Rejections under 35 U.S.C. §103

Claims 14-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Graham or Wasser in view of Official Notice.

It is the position of the Office Action that **Graham** or **Wasser** disclose the invention as claimed, with the exception of the protecting member being made of a synthetic resin. The Office Action relies on Official Notice to provide this teaching, arguing that use of synthetic resin for a protector for a user's foot is old and well known in the art.

In response, Applicant first respectfully submits that claims 14-19 are patentable due to their dependency on independent claim 1, as amended, which Applicant believes is patentable for the reasons discussed above. Additionally, Applicant respectfully requests that the Examiner provide documentary evidence to support the Official Notice.

For at least the foregoing reasons, the claimed invention distinguishes over the cited art and defines patentable subject matter. Favorable reconsideration is earnestly solicited.

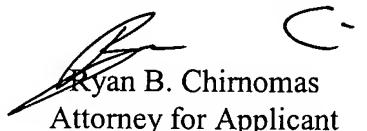
Should the Examiner deem that any further action by applicants would be desirable to place the application in condition for allowance, the Examiner is encouraged to telephone applicant's undersigned agent.

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If this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP



Ryan B. Chirnomas
Attorney for Applicant
Registration No. 56,527
Telephone: (202) 822-1100
Facsimile: (202) 822-1111

RBC/jl